

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-38 remain pending. Claims 1, 19, 20, 21, 30, 31, and 38 are independent.

OBJECTION TO THE SPECIFICATION

The specification is objected to for minor informalities. *See Office Action, page 2.* More specifically, it alleged that the Title of the Invention is not descriptive. The Title of the Invention has been amended as shown above to address this issue. Applicant respectfully requests that the objection to the specification be withdrawn.

OBJECTION TO THE CLAIMS

In the Office Action, claims 18, 25, and 29 stand objected to for informalities. More specifically, it is asserted that there is insufficient antecedent basis for the limitation "second" in these claims. These claims have been amended to address this objection.

Applicant respectfully requests that the objection to claims 18, 25, and 29 be withdrawn.

§ 102 REJECTION – MIYADERA

Claims 1-8, 14-20, 31-34, and 38 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Miyadera (USP 6,133,951). Applicant respectfully traverses.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02.* Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, Miyadera fails to teach or suggest each and every element of the claims. For example, independent claim 1 recites, in part, “while in a photography mode, said image pickup device automatically prompts a user to enter into an information input mode upon recognition of said predefined information on said medium by said recognition section.” Independent claims 19, 20, and 31 also recite similar features. As will be demonstrated below, Miyadera cannot be relied upon to teach or suggest at least this feature.

More specifically, Miyadera is directed toward a still-video camera with function setting operation. Miyadera identifies that in a convention still-video camera, photography can be performed in various modes such as a program mode, an aperture-priority mode, or a shutter speed priority mode, and that

the modes are set by operating a switch provided on the body of the camera. *See column 1, lines 13-17.* Miyadera identifies a problem with such an arrangement in that when the number of photography modes becomes large, the setting operations are tedious. *See column 1, lines 18-21.*

Miyadera solves the above-described problems by providing the still-video camera with a system that recognizes and decodes information of a data symbol. *See column 1, lines 38-44.* An example of a data symbol DS is shown in Figure 4 of Miyadera. Miyadera discloses that the information contained in the data symbol DS corresponds to a photography mode such as exposure mode, a drive mode, information regarding photographic conditions, etc. *See column 6, lines 37-48.*

Miyadera discloses that the camera may be operated in two modes and may be selected by setting the mode setting switch 123 to select the usual photography mode or to select a reading mode. *See column 4, lines 50-52.* When it is desired to obtain information from data symbol DS, the mode selection switch 123 is operated so that the reading mode is selected. *See column 6, lines 51-53.* In other words, **the user must select the reading mode** so that the camera can operate in the reading mode to read the information from the data symbol DS.

When the reading mode is selected, the photographing lens system 3 focus on a predetermined position where beam spots E1 and E2 are substantially completely overlapped with each other on plane B. *See column 6, lines 55-58; and Figure 3.* This is because the video camera of Miyadera can decipher the data symbol DS only when the data symbol is at a predetermined position from the camera. *See column 6, lines 1-13.*

Thus, Miyadera's device can read the information in the data symbol DS only when the user **manually** selects the reading mode using the select switch 123. Further, it is noted that the user must **manually** manipulate the camera and the data symbols so that the data symbol is at a predetermined distance away from the camera.

Thus, it is clear that Miyadera cannot teach or suggest the feature of while in a photography mode, the image pickup device **automatically** prompting the user to enter into an input mode upon recognizing the predefined information on the medium as recited in the independent claims. Therefore, independent claims 1, 19, 20, 31, and 38 are distinguishable over Miyadera.

Claims 2-8, 14-18, and 32-34 depend from independent claims 1 or 32 directly or indirectly. Therefore, for at least the reasons stated with respect to

independent claims 1 and 31, these dependent claims are also distinguishable over Miyadera.

Applicant respectfully request that the rejection of claims 1-8, 14-20, 31-34 and 38 be withdrawn.

§ 103 REJECTION – MIYADERA, KINJO

Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Miyadera in view of Kinjo (USP 6,798,921). *See Office Action, page 9, Item 4.* Applicant respectfully traverses.

First, it should be noted that Kinjo does not qualify as a valid prior art under 35 U.S.C. §103(c). M.P.E.P. clearly indicates that effective November 29, 1999, the subject matter which was prior art under 35. U.S.C. §103/102(e) is disqualified as prior art if the subject matter and the claimed invention were both owned by the same person or subject to an obligation of assignment to the same person. In this instance, Kinjo, if it qualifies at all, can only qualify as prior art under Section 102(e). The present application was filed in 2001 (after November 29, 1999) and both the Kinjo patent and the present application were assigned to a common assignee. Therefore, Kinjo is disqualified as prior art. However, the Examiner may want to consider whether the corresponding published priority application of Kinjo is applicable.

However, even if Kinjo or its corresponding published application is considered to be a valid prior art, a *prima facie* case of obviousness cannot be established as required. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

It is noted that independent claim 1 recites, in part, "while in a photography mode, said image pickup device automatically prompts a user to enter into an information input mode upon recognition of said predefined information on said medium by said recognition section." It has been shown above that Miyadera cannot be relied upon to teach or suggest at least this feature. Kinjo has not been, and indeed cannot be relied upon to correct for at least this deficiency of Miyadera. Therefore, independent claim 1 is distinguishable over the combination of Miyadera and Kinjo.

Claims 9-12 depend from independent claim 1 directly or indirectly. Therefore, for at least the reasons stated with respect to independent claim 1, claims 9-12 are also distinguishable over the combination of Miyadera and Kinjo.

Applicant respectfully request that the rejection of claims 9-12 based on Miyadera and Kinjo be withdrawn.

§ 103 REJECTION – MIYADERA, ANDERSON '431

Claims 13 and 21-30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Miyadera in view of Anderson et al. (USP 6,097,431 hereinafter "Anderson '431"). *See Office Action, page 11, item 5.* Applicant respectfully traverses.

Regarding claim 13, it is noted that claim 13 depends from independent claim 1. It has been shown above that independent claim 1 is distinguishable over Miyadera. Anderson '431 cannot be relied upon to correct for at least the above-noted deficiencies of Miyadera. Therefore, independent claim 1 is distinguishable over the combination of Miyadera and Anderson '431. For at least due to the dependency thereon, claim 13 is also distinguishable over the combination of Miyadera and Anderson '431.

Regarding claims 21-30, it is noted that independent claim 21 recites, in part "while in a photography mode, set image pickup device automatically prompts a user to enter into an information input mode upon recognition of said layer information on said medium by set recognition section." Independent claim 30 recites a similar feature. It has been shown above that

Miyadera cannot be relied upon to teach or suggest this feature and that Anderson '431 cannot be relied upon to correct for at least this deficiency of Miyadera. Therefore, independent claims 21 and 30 are distinguishable over the combination of Miyadera and Anderson '431.

Claims 22-29 depend from independent claim 21 directly or indirectly. Therefore, for at least the reasons stated above with respect to independent claim 21, these dependent claims are also distinguishable over the combination of Miyadera and Anderson '431.

Applicant respectfully requests that the rejection of claims 13 and 21-30 based on Miyadera and Anderson '431 be withdrawn.

§ 103 REJECTION – MIYADERA, ANDERSON '649

Claims 35-37 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Miyadera in view of Anderson (USP 6,683,649, hereinafter "Anderson '649"). Applicant respectfully traverses.

Independent claim 31 recites in part "while in a photography mode, said image pickup device automatically prompts a user to enter into an information input mode upon recognition of said predefined information on said medium by said recognition section." It has been shown above that Miyadera cannot be relied upon to teach or suggest at least this feature. Anderson '649 has not

been, and indeed cannot be, relied upon to correct for at least this deficiency of Miyadera. Therefore, independent claim 31 is distinguishable over Miyadera and Anderson '649.

For at least due to the dependency thereon to independent claim 31, dependent claims 35-37 are also distinguishable over the combination of Miyadera and Anderson '649.

Applicant respectfully requests that the rejection of claims 35-37 based on Miyadera and Anderson '649 be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

U.S. Application No. 09/855,539

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: 

Marc S. Weiner

Reg. No. 32,181

HNS

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000

MSW/HNS/lab/csm
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Attachment(s):